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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,465	04/24/2001	Seth Haberman	20429/9-C	5373
28089 7590 12/18/2006 WILMER CUTLER PICKERING HALE AND DORR LLP 399 PARK AVENUE NEW YORK, NY 10022			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT 2623	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/841,465

Applicant(s)

HABERMAN ET AL.

Examiner

Michael Van Handel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/2006 has been entered.

### ***Response to Amendment***

1. This action is responsive to an Amendment filed 10/19/2006. Claims **1-19, 21** are pending. Claims **1, 3-5, 8, 10, 12-19, 21** are amended. Claim **20** is canceled.

### ***Response to Arguments***

1. Applicant's arguments regarding claims **1, 16, and 19**, filed 10/19/2006, have been considered, but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments regarding claim **21**, filed 10/19/2006, have been fully considered, but they are not persuasive.

Regarding claim **21**, the applicant argues that Klosterman et al. does not show or suggest creating a plurality of different video and audio media segments, wherein said different media segments include incomplete sections of a complete non-interactive advertisement. The applicant further argues that Klosterman et al. does not show or suggest assembling a complete

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non-interactive advertisement. The examiner respectfully disagrees. Klosterman et al. discloses systems and methods for allowing a network to set up multiple channels of advertising, e.g., FOX, FOX1, FOX2, etc. Each channel could provide a separate program of advertising synchronized in time to coincide with advertising delivered on the main channel, e.g., FOX. For example, the television set of an individual viewer who is watching the SuperBowl on FOX, will be automatically tuned, in a manner invisible to the viewer, to one of the multiple FOX channels during a commercial break (p. 2, paragraph 31). Klosterman et al. also discloses that the criteria for selecting the channel to which a particular viewer's television will be tuned may consider an individual viewer's profile (p. 2, paragraph 32). Klosterman et al. further discloses that the television system uses Viewer Profile information to customize the presentation and/or scheduling of telecast advertisements that are viewable during the real time telecast of the television program that the viewer is watching. One example is customizing an overlay message to an advertisement on a local geographic basis. Customized messages can be preloaded by zip code into the memories of particular viewers' television system, as through an EPG. The preloaded messages can be transmitted by a head end during off hours and stored in the viewer's terminal for use when the advertisement runs. The electronic trigger to run the message can be transmitted along with the television signal in real time and can identify the messages stored in the user terminal that need to be applied (p. 6, paragraph 71). Since the messages add to the broadcast advertisements, the examiner interprets such advertisements to be incomplete sections of a complete non-interactive advertisement, as claimed. Thus, the examiner maintains that Klosterman et al. meets the limitations "creating a plurality of different video and audio media segments, wherein said different media segments include incomplete sections of a complete non-

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interactive advertisement” and assembling a “complete non-interactive advertisement,” as currently claimed.

***Claim Rejections - 35 USC § 112***

1. Claims **1-18, 21** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the examiner fails to find a recitation of the subject matter corresponding to the claimed “non-interactive” in the applicant’s specification.

***Claim Objections***

1. Claim **21** is objected to because of the following informalities:

Referring to claim **21**, the examiner notes that the phrase “said at least one subset” lacks antecedent basis. The examiner recommends that the phrase be changed to “at least one subset.” The examiner addresses the claim in the Office Action below as though the recommended changes have been made.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 8, 9, 12, 13, 15, 16, 18, 19, 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Klosterman et al.

Referring to claims 1, 16, and 19, Klosterman et al. discloses a method/system for allowing the creation of a plurality of non-interactive personalized advertisements to be viewed by an intended audience, comprising:

- creating a personalized advertisement template comprising a plurality of media slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots (p. 3, paragraphs 38-40, 42, 44, 45, 48);
- providing a plurality of data streams to a receiving unit, each data stream delivering a different one of said plurality of media segments for said at least one of said slots, wherein said media segments are synchronized to begin and end at substantially the same time (p. 2, paragraph 31 & p. 3, paragraph 39); and
- providing content selection information regarding content of said plurality of data streams to said receiving unit, said information including switch times for said plurality of synchronized media segments, to allow said receiving unit to select among said plurality of data streams for one of said media segments for said particular slot (p. 2, paragraphs 32, 33; p. 3, paragraphs 38-40, 42; & p. 4, paragraphs 44, 45, 48), to assemble a non-interactive personalized advertisement (p. 6, paragraph 71).

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Further referring to claims **16** and **19**, Klosterman et al. discloses that one of said data streams transmits content selection information regarding content of said plurality of data streams said information including switch times for allowing a receiving unit to switch among said plurality of data streams to select a particular media segment at a particular time (p. 3, paragraphs 38, 39), to assemble a non-interactive personalized advertisement (p. 6, paragraph 71).

Referring to claim **2**, Klosterman et al. discloses the method of claim 1, wherein said receiving unit selects among said plurality of data streams in real time (Klosterman et al. discloses automatically tuning the television set of an individual viewer to one of multiple FOX channels of advertising during a commercial break, in a manner invisible to the viewer. The examiner interprets this as selecting among the plurality of channels in real time)(p. 2, paragraph 31 & p. 4, paragraphs 44, 45).

Referring to claim **3**, Klosterman et al. discloses the method of claim 1, wherein said personalized advertisement is viewed by a viewer as it is assembled (p. 6, paragraph 71).

Referring to claim **4**, Klosterman et al. discloses the method of claim 1, wherein said receiving unit selects among said plurality of data streams based on said content selection information and information about a viewer who will view said personalized advertisement (p. 3, paragraph 40).

Referring to claim **5**, Klosterman et al. discloses the method of claim 4, further including providing a data stream with a default personalized advertisement to allow said receiving unit to display said default personalized advertisement without selecting between said plurality of data streams (the examiner notes that in the SuperBowl example, the beer commercial is the commercial displayed on Channel A with the SuperBowl program. Thus, the examiner interprets

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the beer commercial to be a default personalized advertisement, as claimed)(p. 4, paragraphs 44, 45).

Referring to claim 8, Klosterman et al. discloses the method of claim 1, wherein said segments are incomplete parts of a personalized advertisement (the examiner notes that Klosterman et al. discloses preloading advertisement overlay messages into the memories of a viewers' television system. When the advertisement is broadcast, the overlay message is displayed with it. The examiner interprets these advertisements to be incomplete sections of a complete non-interactive advertisement, as claimed (p. 6, paragraph 71).

Referring to claim 9, Klosterman et al. discloses the method of claim 1, wherein said receiving unit is a set top box (p. 3, paragraph 35).

Referring to claims 12 and 18, Klosterman et al. discloses the method/system of claims 9 and 16, respectively, wherein said set top box momentarily switches from a first digital data stream to a second digital data stream to play out a personalized advertisement (p. 2, paragraph 31 & p. 3, paragraphs 35, 40).

Referring to claim 13, Klosterman et al. discloses the method of claim 9, wherein said set top box receives a plurality of television channels over said data streams, and said channels include programs including a synchronized commercial break; and during said synchronized commercial break, said data streams deliver segments to create a personalized advertisement for display irrespective of which channel said set top box had selected (p. 2, paragraph 31; p. 3, paragraphs 38-40, 42; & p. 4, paragraphs 44, 45).

Referring to claim 15, Klosterman et al. discloses the method of claim 1, further including a plurality of templates for creating said personalized advertisements, wherein said



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templates include video sequence templates and audio sequence templates (the examiner notes that each channel shows a series of advertisements back-to-back. These advertisements include video and audio. Since these advertisements can be modified by adding overlays to create a more personalized advertisement, the examiner interprets the original channel advertisements to be have video sequence templates and audio sequence templates that are used with the overlay messages to create more personalized advertisements)(p. 2, paragraph 31; p. 3, paragraphs 38-40, 42; p. 4, paragraphs 44, 45; & p. 6, paragraph 71).

Referring to claim **21**, Klosterman et al. discloses a method for delivering a plurality of different non-interactive advertisements over a television transmission network, comprising:

- creating a plurality of different video and audio media segments, wherein said different media segments include incomplete sections of a complete non-interactive advertisement (a network can set up multiple channels of advertising, e.g., FOX, FOX1, FOX2, etc. The examiner further notes that Klosterman et al. discloses preloading advertisement overlay messages into the memories of a viewers' television system. When the advertisement is broadcast, the overlay message is displayed with it. The examiner interprets these advertisements to be incomplete sections of a complete non-interactive advertisement, as claimed)(p. 1, paragraph 10; p. 2, paragraph 31; & p. 6, paragraph 71);
- transmitting a plurality of television programs to a television signal receiver, wherein said plurality of television programs have at least one synchronized commercial break (p. 2, paragraph 31 & p. 3, paragraph 39);

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- during said synchronized commercial break, transmitting said plurality of different media segments to said television signal receiver, wherein all media segments in at least one subset are transmitted simultaneously (p. 2, paragraph 31 & p. 3, paragraphs 38, 39);
- directing said television signal receiver to switch to one of said media segments in said subset as said media segments in said subset are received to assemble said complete non-interactive advertisement (p. 3, paragraph 42 & p. 6, paragraph 71); and
- wherein after said synchronized commercial break, said television signal receiver switches to a previously selected television program (p. 4, paragraphs 44, 45).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al. in view of Ten Kate et al.

Referring to claim 6, Klosterman et al. discloses the method of claim 1. Klosterman et al. does not disclose that the plurality of data streams are MPEG encoded data streams. Ten Kate et al. discloses encoding video streams in MPEG-2 (col. 3, l. 39-41, 61-67). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the

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channels of Klosterman et al. to be MPEG encoded, such as that taught by Ten Kate et al. in order to achieve a higher compression rate.

3. Claims 7, 10, 11, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al. in view of Picco et al.

Referring to claim 7, Klosterman et al. discloses the method of claim 1. Klosterman et al. does not disclose that the plurality of data streams are multiplexed into a transport stream. Picco et al. discloses multiplexing live television feeds 106, local content streams 108 and various other signals into a digital data stream that is then transmitted to a user (col. 8, l. 56-67 & Fig. 5). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the channels of Klosterman et al. to be multiplexed into a digital data stream, such as that taught by Picco et al. in order to provide individualized local content in a digital stream by transmitting to the user a single multiplexed data stream (Picco et al. col. 2, l. 42-44).

Referring to claims 10, 11, and 17, Klosterman et al. discloses the method/system of claims 9 and 16. Klosterman et al. further discloses that the invention can receive analog television and digital television (p. 3, paragraph 35). Klosterman et al. still further discloses switching advertisements in response to a channel change command in the vertical blanking interval (VBI) (p. 3, paragraph 38). Klosterman et al. does not disclose that the set top box momentarily switches from an analog data stream to a digital data stream to play out a personalized advertisement triggered by VBI data. Picco et al. discloses a set top box 120 (Fig. 7) that can receive both analog data streams and digital data streams (col. 14, l. 62-67). Picco et al. further discloses that the set top box 120 activates a web browser in response to a user

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selection when the user sees a television advertisement, which references a particular web site (col. 14, l. 17-41 & Fig. 11). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the VBI triggered advertisement switching of Klosterman et al. to include switching from an analog stream to a digital stream to display advertising information, such as that taught by Picco et al. in order to provide a television viewer with advertising from the Internet.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al. in view of Kunkel et al.

Referring to claim 14, Klosterman et al. discloses the method of claim 1. Klosterman et al. does not disclose including transition segments, which are inserted into a personalized advertisement between segments. Kunkel et al. discloses encoding video streams in MPEG1 or MPEG2. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the channels of Klosterman et al. to be MPEG encoded, such as that taught by Kunkel et al. in order to achieve a higher compression rate. Kunkel et al. further discloses sending I-frames continuously at the beginning of targeted ads, so that the set top box tuners can quickly acquire the signal. Similarly, a continuous stream of I-frames is provided for the last few seconds of the advertisement to enable the tuners to quickly reacquire the original channel once the advertisement has concluded (p. 4, paragraph 31). It would have been obvious one of ordinary skill in the art at the time that the invention was made to modify the combination of Klosterman et al. and Kunkel et al. to include continuously sending I-frames at the beginning

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and end of advertisements, such as that taught by Kunkel et al. in order to facilitate seamless transitions between advertisements and original programming (Kunkel et al. p. 4, paragraph 31).

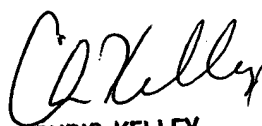
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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